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Date: April 6, 2004

Paul L. Hickman

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:

Paul L. Hickman, et al.

APPLICATION No.: 09/294,760

FILED: April 19, 1999

FOR: **METHOD, APPARATUS, DATA STRUCTURE
AND ARTICLE OF MANUFACTURE FOR
MONITORING MULTIPLE ELECTRONIC MAIL
SYSTEMS**

EXAMINER: PIERRE E. ELISCA

ART UNIT: 3621

CONFIRMATION: 6481

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Reply Brief Transmittal

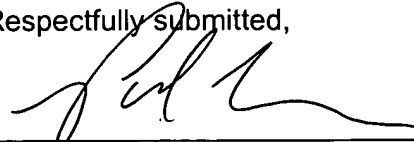
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Sir:

Further to the Examiner's Answer mailed February 6, 2004, enclosed herewith are the following:

- ☒ Applicant's "Reply Brief," in triplicate.
 - ☒ No fee is believed to be due for the filing of this Reply Brief. If there is any fee due, please charge any such fee to Deposit Account No. 50-2207.
 - ☒ While no petition for an extension of time is considered to be needed, please consider this a conditional petition for extension of time should one be needed. Please charge any underpayment for timely consideration of this paper to Deposit Account No. 50-2207.

Respectfully submitted,



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PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

EX PARTE Hickman et al.

Application for Patent

Filed April 19, 1999

Serial No. 09/294,760

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REPLY BRIEF

**FOR: METHOD, APPARATUS, DATA STRUCTURE
AND ARTICLE OF MANUFACTURE FOR MONITORING
MULTIPLE ELECTRONIC MAIL SYSTEMS**

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Paul Hickman

Applicant's Reply

Applicant filed an Appeal Brief on October 17, 2003. An Examiner's Answer was provided on February 6, 2004. Applicant respectfully requests that the following remarks be considered as Applicant's Reply to the Examiner's Answer.

Examiner's Claim Rejections

The Examiner rejects claims 1, 2, 8, 10, 11 and 18-20 over Thomson. The Examiner admits that Thompson does not "specifically disclose polling plural e-mail accounts but rather a voice-mail account and an e-mail account." Applicant's question is a simple one: how does one consolidate voice-mail and e-mail accounts? The answer is, you can't. Applicant's invention does not poll multiple types of communications for retrieval, as taught by Thompson but, rather, retrieves e-mail from multiple e-mail accounts and consolidates them in a single e-mail account for a user.

As thoroughly explained in Applicant's Brief, Thomson cannot be programmed to access multiple e-mail accounts. A technical analysis of Thompson (*see*, for example, Applicant Brief, pages 4-5) makes it clear that this functionality is impossible. This technical analysis was never rebutted by the Examiner for the not surprising reason that multiple e-mail accounts are not supported in Thompson's PBX environment. The Examiner's statements of the "addition of condition diamonds is considered to be obvious to anyone who has computer programming ability" is both conclusory and misses the point. Additional diamonds for other types of communications found in a PBX system may, *arguendo*, be obvious, but an additional diamond for a plurality of e-mail accounts on a system that doesn't support multiple e-mail accounts is not only non-obvious, it is impossible.

Instead of making a technical rebuttal, the Examiner creates, out of thin air, a hypothetical PBX system wherein a Thompson process polls both a "help desk" e-mail account and a personal e-mail account for a user. Applicant respectfully submits that this is inappropriate and a gross use of hindsight fabrication on the part of the Examiner. Furthermore, Thompson's invention cannot be used as hypothesized by the Examiner.

Even if such an argument were to be considered, it fails to meet the limitations of Applicant's claims. That is, even if, *arguendo*, the process of Fig. 8 were modified to access a second e-mail account, *the two e-mail accounts would not be consolidated as claimed by Applicant*. Thompson does not consolidate. Thompson retrieves voice-mail and e-mail and faxes. Each would be retrieved by its own process and played or displayed by its own process. There simply is no capability of consolidation in Thompson's system.

Implicit in Applicant's invention is the concept of a consolidated account. That is, a first or primary e-mail account is used to consolidate e-mails from at least one secondary e-mail account. In that fashion a user only has to access the primary e-mail account to access e-mail from the secondary e-mail account(s) as well. This is a tremendous savings in time and energy for the user. No such savings would be provided with Thompson, even in the above-described hypothetical, since Thompson does not teach consolidation of one or more secondary accounts into a primary account.

The Examiner further rejects claims 12-14 as being unpatentable over Thompson in view of Cooper. As discussed, below, these references are not properly combinable as set forth by the Examiner. However, even if they were combined, not all of the elements of the claims are found in the combination. Importantly, the combination of Thompson and Cooper do not teach communication with a plurality of external electronic mail accounts. Thompson is a PBX system and local area network (LAN) without any external communications channel and, therefore, cannot access any external e-mail accounts, let alone a plurality of external electronic mail accounts. Cooper is a telephone answering machine with the capability of dialing up an external e-mail system and downloading its e-mail. Cooper is therefore a local e-mail proxy. However, Cooper does not access a plurality of external electronic mail accounts.

Since the combination of Thompson and Cooper do not teach accessing a plurality of external electronic mail accounts, then also do not teach a poller operative to generate inquiries to a plurality of external electronic mail accounts. Nor do they include a data retriever operative to receive data concerning mail intended for a designated user from the plurality of external electronic mail accounts. Nor do they include a consolidator developing data concerning the designated user from the plurality of electronic data accounts.

It should also be noted that claims 12-14 do not meet the discredited "help desk" hypothetical set forth by the Examiner. That is, independent claim 12 retrieves and consolidates e-mail for a designated user. In the Examiner's hypothetical, the e-mail is retrieved from a group e-mail account and the designated user's account, not multiple accounts for the designated user.

Examiner's Response to Argument

The Examiner leads off his response with the "help desk" hypothetical as a reason why multiple e-mail accounts on a PBX system would be obvious. He indicated that it was not only conceivable but "highly probable" that a user would have both personal and group e-mail directed to him. Applicant again objects to this completely unsupported hypothetical, especially one characterized by the Examiner as "highly probable." However, it should be noted that the Examiner indicated that the mail would be "directed" to the hypothetical person, not that it would be consolidated for that person.

In an effort to minimize redundancy, Applicant will not fully address this issue as it has been discussed in some length above and in Applicant's Appeal Brief. However, Applicant would like to point out another inconsistency in the Examiner's arguments. The Examiner first sets up a hypothetical by adding an additional e-mail polling operation to Thompson's PBX system, comparing the modified Thompson system to the system taught by Applicant, and then arguing that the modified Thompson system and Applicants system are obvious, citing *St. Regis Paper Co. St. Regis* is, of course, the case which said that adding another ply to a multi-ply paper bag is not patentable, *without some showing of a synergistic combination*. However, Applicant's invention does have synergy between his multiple e-mail retrievals in that the e-mail from all of the accounts is consolidated. Therefore, the Examiner's logic also fails because, under the holding of *St. Regis*, Applicant's combination is patentable over the modified Thompson PBX due to the synergies of combining multiple e-mail accounts into one e-mail account, which the hypothetical Thompson PBX system does not do.

Finally, the Examiner cites *In re Fine* for the proposition that the motivation to combine references for a 103 rejection does not need to come from the references themselves. Actually, *In re Fine* concludes just the opposite:

Fine says the PTO has not established a *prima facie* case of obviousness. He contends that the references applied by the Board and the

Examiner were improperly combined, using hindsight reconstruction, without evidence to support the combination and in the face of contrary teachings in the prior art....

We agree. The PTO has the burden under section 103 to establish a prima facie case of obviousness. This it has not done. The Board points to nothing in the cited references, either alone or in combination, suggesting or teaching Fine's invention. ...

Obviousness ... cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. ... And teachings of references can be combined *only* if there is some suggestion or incentive to do so. ... Here, the prior art contains none.

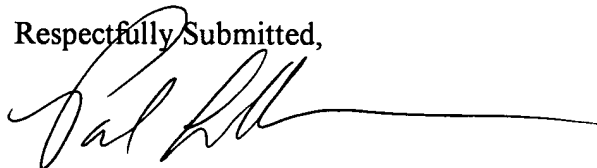
Instead, the Examiner relies on hindsight in reaching his obviousness determination. In re Fine, 5 USPQ2d 1598-1599 (Fed. Cir. 1988)

The other cases cited by the Examiner are just as far off base. In fact, Applicant fails to find the support for the statements made by the Examiner in the cited cases. However, since the Examiner is apparently admitting that the prior art does not suggest the combination claimed by Applicant, his rejection of the claims was in error for this reason as well.

Conclusion

As noted, none of the cited art, either alone or in combination, can be said to anticipate or render obvious the appealed claims. Accordingly, Applicant believes the rejections to be in error, and respectfully requests the Board of Appeals and Interferences to reverse the Examiner's rejections of the claims on appeal.

Respectfully Submitted,



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